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JOHN W. HAWAY PLLC

FAX NO. 2648144

P. 02/26



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/896,514 06/23/97 GARDNER

C 95-004M

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PM82/0606

CONRAD O GARDNER
UNITE 2202
121 VINE STREET
SEATTLE WA 98121

EXAMINER

MAR, M

ART UNIT	PAPER NUMBER
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3619

37

DATE MAILED: 06/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
08/896,514

Applicant(s)

Conrad O. Gardner

Examiner

Michael Mar

Group Art Unit

3619

☒ Responsive to communication(s) filed on May 2, 2000☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 30-41 and 46-61 is/are pending in the application.Of the above, claim(s) 30-33 is/are withdrawn from consideration.☐ Claim(s) _____ is/are allowed.☒ Claim(s) 34-41 and 46-61 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Due to the omission of lines 3-8 from original claim 61, amended claim 61 now lacks antecedent basis for the recitations "power transfer means for transferring an output power of said engine" and "power transfer means for transferring an output power of said electric motor".

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 34-41 and 46-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,301,764.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims are not considered to be patentable differences and would have been obvious to one having ordinary skill in the art. They are also not considered to be patentably distinct since the claims in the patent are drawn to the same elected specie as the claims in the pending application.

5. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to *Group Art Unit 3619*.

6. Any response to this action should be mailed to:

Assistant Commissioner for Patents

Washington, D.C. 20231

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or faxed to:

(703) 308-2571

(for formal communications intended be entered)

(all informal communications should be labeled "PROPOSED" OR "DRAFT")

or hand delivered to:

Crystal Park 5, 2451 Crystal Drive, Arlington, Virginia 22202

Seventh Floor(receptionist)

7. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Michael Mar at telephone number (703) 308-2087, or by e-mail to:

michael.mar@uspto.gov

Any inquiry of a general nature or relating to the-status of this application or proceeding
should be directed to the receptionist whose telephone number is (703) 308-1113.

Michael Mar

MICHAEL MAR

Primary Examiner

6-4-00

M.Mar

6-4-2000